UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,817	05/22/2001	Michael Ferris	10010.1067CPAC	9433

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EXAMINER
VU, THONG H

ART UNIT	PAPER NUMBER
2142	

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/863,817	FERRIS ET AL.
	Examiner	**Art Unit**
	Thong H Vu	2142

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 May 2001*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-35* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 May 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

1.   Claims 2-35 are pending.

Double Patenting

2.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2-35 are rejected under the judicially created doctrine of double patenting over claims 1-31 of U. S. Patent No. 6,253,228 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

(Application, Claim 18). An article of manufacture comprising:

a computer usable medium having computer readable program code embodied therein <u>for synchronizing information between a first computer and a second computer</u>, the computer readable program code in said article of manufacture comprising:

computer readable program code configured <u>to initialize a communication system</u>, said communication system comprising computer readable program code configured to cause said computer to:

<u>maintain keys and values; accept user input; and determine when to invoke an action</u>; computer readable program code configured to cause said first computer to <u>construct a first package</u>, wherein said first package is comprised of said keys and values;

computer readable program code configured to transmit said first package to said second computer;

computer readable <u>program code configured to synchronize information between said second computer</u> and said first computer, said code comprising:

code configured to cause said second computer to obtain said first package at said second computer;

computer readable program code configured to bind said <u>second computer dictionary's values to variables in said second computer</u>;

code configured to cause said second computer to obtain synchronization information, wherein said computer readable program code configured to obtain synchronization information further comprises:

computer readable program code configured to <u>compare said bound variables with said keys and values from said first package</u>;

computer readable program code configured to <u>place said keys and said values associated with said fist package keys and values in said synchronization information</u>;

code configured to cause said second computer to <u>transmit said synchronization information to said first computer</u>;

code configured to cause said first computer to be <u>updated with said synchronization information</u>.

(Patent '228, claim 1). A method for <u>synchronizing information between a client and a server</u> comprising the steps of <u>initializing a communication system</u> between said client and said server, said communication system comprising a plurality of objects, said objects capable of:

<u>maintaining keys and values; accepting user input; and determining when to invoke an action</u>; wherein said initializing a communication system further comprises creating a server dictionary of said values on said server; said client <u>constructing a first package</u>, wherein said first package is comprised of said keys and values;

said client transmitting said first package to said server; <u>synchronizing information between said server and said client</u> comprising the steps of said server using said first package;

updating said <u>server dictionary with said keys and values from said first package; binding said server dictionary's values to variables in said server</u>;

said server constructing synchronization information based on said first package, wherein said constructing synchronization information comprises the steps of:

<u>comparing said bound variables with said server dictionary's values</u>;
<u>placing said keys and said values that have changed in said synchronization information</u>;

said server <u>transmitting said synchronization information to said objects</u>;

said objects <u>updating said client with said synchronization information</u>.

Furthermore, there is no apparent reason why applicant was prevented from

presenting claims corresponding to those of the instant application during prosecution of

the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158

USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 2-35 are rejected under 35 U.S.C. § 103 as being unpatentable over Liu

[5,953,005] in view of Uchida et al [Uchida, 4,583,221].

4.   As per claim 18, Liu discloses an article of manufacture comprising:

a computer usable medium having computer readable program code (i.e.: applet)

embodied therein for synchronizing information between a first computer and a second

computer [Liu, applet, update process, synchronization function, abstract], the computer

readable program code in said article of manufacture comprising:

computer readable program code configured to initialize a communication

system, said communication system comprising computer readable program

code configured to cause said computer to:

maintain keys and values [Liu, audio, video, timing data and lyric

information, col 4 line 63-col 5 line 8];

accept user input [Liu, user selection, col 6 lines 27-50]; and

determine when to invoke an action [Liu, applet are automatically

downloaded, col 3 lines 53-64];

computer readable program code configured to cause said first computer

to construct a first package (i.e.: a multimedia file), wherein said first package is

comprised of said keys and values [Liu, applet with a number of choices, col 4 lines 34-

62];

computer readable program code configured to transmit said first

package to said second computer [Liu, applet are automatically downloaded, col 3 lines

53-64];

computer readable program code configured to synchronize information

between said second computer and said first computer [Liu, synchronization, col 6 line

51-col7 line 50, col 8 lines 1-20], said code comprising:

code configured to cause said second computer to obtain said first

package at said second computer [Liu, applet are automatically downloaded, col 3 lines

53-64];

computer readable program code configured to bind said second

computer dictionary's values (i.e.: database) to variables in said second computer [Liu,

a master database, col 3 lines 35-52];

code configured to cause said second computer to obtain synchronization

information [Liu, synchronization, col 6 line 51-col 7 line 50, col 8 lines 1-20], wherein

said computer readable program code configured to obtain synchronization information

further comprises:

computer readable program code configured to place said keys and

said values associated with said fist package keys and values in said synchronization

information [Liu, browser providing access to a page which has a plurality of elements

including multimedia audio, graphics, text and timing data elements and instructions

when executed synchronize the delivery elements, col 11 lines 50-67];

code configured to cause said second computer to transmit said

synchronization information to said first computer [Liu, delivery in a synchronized

manner, col 6 lines 51-67];

code configured to cause said first computer to be updated with said

synchronization information [Liu, updated, col 6 lines 28-50].

However Liu does not explicitly detail

computer readable program code configured to compare (or bind) said

bound variables with said keys and values from said first package;

It was well-known in the synchronization art that the synchronized program must

reads and compares the elements (i.e.: keys and values) before initial the

synchronization [see Uchida reference, the variable synchronizing code detector

receives and compares the variable code with the previously received, col 2 line 55-col

3 line 14]

Therefore, it would have been obvious to one having ordinary skill in the art at

the time the invention was made to incorporate the technique of comparing the

elements before synchronization process as taught by Uchida into the Liu's apparatus in

order to utilize the synchronization process. Doing so would provide a secure data and

enchance the synchronization process between client and server.

5.   As per claim 19, Liu-Uchida disclose computer readable program code

(i.e.:applet) configured to create a controller; computer readable program code

configured to create an action coordinator; and computer readable program code

configured to create an associations between said controller and said action coordinator

as inherent feature of applet.

6.   As per claim 20, Liu-Uchida disclose computer readable program code

configured to extract said keys and said values; and computer readable program code

configured to create a first computer dictionary of said extracted keys and extracted

values on said first computer [Uchida, the variable synchronizing code detector receives

and compares the variable code with the previously received, col 2 line 55-col 3 line 14].

7.   As per claim 21, Liu-Uchida disclose computer readable program code

configured to place said keys and their corresponding values that have changed at said

first computer as a result of said user input in said first package [Uchida, the variable

synchronizing code detector receives and compares the variable code with the

previously received, col 2 line 55-col 3 line 14].

8.   As per claim 22, Liu-Uchida disclose computer readable program code configured to transmit said first package from said action coordinator to a communications channel; and computer readable program code configured to transmit said first package from said communications channel to said second computer [Liu, applet are automatically downloaded, col 3 lines 53-64].

9.   As per claim 23, Liu-Uchida disclose said synchronization information comprises updated keys and updated values [Liu, updated, col 6 lines 28-50].

10.   As per claim 24, Liu-Uchida disclose computer readable program code configured to transmit said synchronization information from said second computer to said communications channel; and computer readable program code configured to transmit said synchronization information from said communications channel to said action coordinator [Liu, download and synchronization, abstract].

11.   As per claim 25, Liu-Uchida disclose computer readable program code configured to update said first computer dictionary with said keys and said values from said synchronization information [Liu, updated, col 6 lines 28-50].

12.   As per claim 26, Liu-Uchida disclose computer readable program code configured to display said updated values at said first computer [Liu, updated, col 6 lines 28-50].

13. As per claim 27, Liu-Uchida disclose computer readable program code

configured to transmit updated values from said synchronization information to said

action coordinator; computer readable program code configured to display said updated

values [Liu, updated, col 6 lines 28-50].

14. Claims 2-17 and 28-35 contain the similar limitations set forth of apparatus

claims 18-27. Therefore, claims 2-17,28-35 are rejected for the similar rationale set forth

in claims 18-27.

15. Any inquiry concerning this communication or earlier communications from the
examiner should be directed to examiner Thong Vu, whose telephone number is (703)-
305-4643.
The examiner can normally be reached on Monday-Thursday from 8:00AM- 4:30PM.
        If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, *Jack Harvey*, can be reached at (703) 305-9705.
        Any inquiry of a general nature or relating to the status of this application should
be directed to the Group receptionist whose telephone number is (703) 305-9700.
        Any response to this action should be mailed to: Commissioner of Patent and
Trademarks, Washington, D.C. 20231 or faxed to :
                After Final   (703) 746-7238
                Official: (703) 746-7239
                Non-Official (703) 746-7240
        Hand-delivered responses should be brought to Crystal Park 11,2121 Crystal
Drive, Arlington. VA., Sixth Floor (Receptionist).

Thong Vu
Patent Examiner
Art Unit 2142